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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,049	02/02/2004	John N. Gross	JNG 2004-5	1525

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/771,049		GROSS, JOHN N.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Dennis Ruhl		3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 21-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 21-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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Applicant's amendment of 12/12/05 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 26, the scope of this claim is not clear. Claim 25 recites that the notification includes an identification of an additional media item that is being added to the rental queue. Claim 26 recites that the media item is only tentatively added. What does this mean? The item is either being added or it is not being added. The examiner feels that the language of claim 26 is broadening the claim scope, not narrowing it because tentatively adding something is not the same as actually adding it. What is the scope of this claim and is the item being added or not?

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,3,4,6,10-17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings et al. (6584450) in view of Pennell et al. (6874023).

For claims 1,3,4,6,17, Hastings discloses a method for renting items where the customer sets up a rental queue. A set of queue replenishment rules are employed to determine if the ordering of the titles in the queue should be changed. When a DVD is returned (a trigger) the system checks the queue rules (Max Out option and/or Max Turns) to determine if the ordering of the queue should be changed. When a new DVD is shipped, the ordering of the queue is changed because that title is taken out of the queue and is then in a checked out status. Not disclosed is a set of notification rules that will electronically notify the subscriber when the ordering of the queue has been changed by monitoring the queue. Pennell discloses a system and method where a customer who has an account with a particular web site can be notified of any changes in their account electronically by use of a computer. Pennell discloses notification of changes such as miles being added to a Frequent Flyers account or trades being made at eSchwab (online trading). Pennell recognizes that it may be too time consuming for the customer to continually log into their account at the respective web site and discloses that the notification system makes this process much easier and more user friendly. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the subscriber of Hastings with the ability to monitor their queue and receive notifications when changes are made as disclosed by Pennell (identify items that are being shipped and informing them that the order of the queue is

changed) so that the customer does not have to continually log into their account to be informed of account changes.

For claims 10,11, Hastings discloses a movie recommendation system. When movies are recommended this can be taken as a suggestion to add them to the queue because that is the reason they are being suggested to the subscriber.

For claim 12, not disclosed is the receiving of feedback. It would have been obvious to one of ordinary skill in the art to solicit and receive feedback on the movie recommendation system so that you can improve it and make it more accurate to what the customer actually likes. Customer feedback is nothing new.

For claim 13, if the subscriber desires to do so, they can stop the receiving of notifications concerning their rental queue. They can have the notifications stopped. The prior art is fully capable of what is claimed.

For claims 14-16, Hastings discloses movies. With respect to the recitations about how the movies are distributed, because no distribution of anything is being positively claimed the examiner has given this language minimal patentable weight. The claims are only directed to the notification of a change in the rental queue, not the distribution of the movies. All that is claimed is that the playable media is movies.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 25 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claims 1,8, of copending Application No. 10770767 in view of Pennell et al. (6874023). Although the conflicting claims are not identical, they are not patentably distinct from each other because the recitation of electronically notifying the subscriber to the change made to the rental queue is considered to be obvious in view of the reference to Pennell. Pennell discloses a system and method where a customer who has an account with a particular web site can be notified of any changes in their account electronically by use of a computer. Pennell discloses notification of changes such as miles being added to a Frequent Flyers account or trades being made at eSchwab (online trading). Pennell recognizes that it may be too time consuming for the customer to continually log into their account at the respective web site and discloses that the notification system makes this process much easier and more user friendly. It would have been obvious to one of

ordinary skill in the art at the time the invention was made to provide the subscriber of Hastings with the ability to monitor their queue and receive notifications when changes are made as disclosed by Pennell (identify items that are being shipped and informing them that the order of the queue is changed) so that the customer does not have to continually log into their account to be informed of account changes.

7. Claim 25 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claims 1,5, of copending Application No. 10771094 in view of Pennell et al. (6874023). Although the conflicting claims are not identical, they are not patentably distinct from each other because the recitation of *electronically notifying* (as opposed to the claimed "notification" in the '094 case, see claim 5) the subscriber to the change made to the rental queue is considered to be obvious in view of the reference to Pennell. Pennell discloses a system and method where a customer who has an account with a particular web site can be notified of any changes in their account electronically by use of a computer. Pennell discloses notification of changes such as miles being added to a Frequent Flyers account or trades being made at eSchwab (online trading). Pennell recognizes that it may be too time consuming for the customer to continually log into their account at the respective web site and discloses that the notification system makes this process much easier and more user friendly. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the subscriber of Hastings with the ability to monitor their queue and receive electronic notifications when changes are made as

disclosed by Pennell (identify items that are being shipped and informing them that the order of the queue is changed) so that the customer does not have to continually log into their account to be informed of account changes.

8. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. A terminal disclaimer is also required in order to maintain common ownership of claims of overlapping scope.

***Allowable Subject Matter***

9. Claims 21-25,27-29,30-34 are allowed.

10. Claims 2,5,7-9,18, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claim 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. Applicant's arguments filed 12/12/05 have been fully considered but they are not persuasive. With respect to the argument that Hastings does not disclose queue replenishment rules, the examiner disagrees. Hastings discloses rules that govern when and how the queue ordering is to be changed (Max Out option and/or Max Turns).

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There are rules that control the ordering of titles in the queue as claimed. If you return two movies, you get two more sent out and they come off the rental queue list and are now in a checked out status. This satisfies what has been claimed because the ordering of the queue has been changed. With respect to Pennell, the argument that Pennell does not disclose queue replenishment rules is noted but this feature is found in the primary reference and this is not the reason that Pennell was relied upon; therefore the argument is non-persuasive. The examiner does not see any real argument concerning the 103 rejection and the obviousness statement of the examiner. The 103 rejection is deemed as proper.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL  
PRIMARY EXAMINER